UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087335,461	11/07/94	GIERSET	R

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EXAMINER	
LOW,C	

ART UNIT	PAPER NUMBER
1804	

DATE MAILED: 03/11/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

See the attached Sheets.

Christopher S. F. Low

CHRISTOPHER S. F. LOW
PRIMARY EXAMINER
GROUP 1800

FILE COPY

Advisory Action

Application No.	Applicant(s)
08/335,461	Gjerset et al.
Examiner	**Group Art Unit**
Christopher S. F. Low	1804

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on *24 Oct 1996* (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on *13 Feb 1997* has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

☒ Applicant's response has overcome the following rejection(s):

none

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See the attached sheets.

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: *none*

Claims objected to: _____

Claims rejected: *1, 2, 4-20, and 23*

☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

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PRIMARY EXAMINER
ART UNIT 1804

The supplemental disclosure statement filed 13 December 1996 has been placed in the file but has not been further considered insofar as applicant admits of its noncompliance to 37 C.F.R. 1.98.

The amendment and comments in the response after final filed 13 February 1997 have been entered and considered but are not persuasive as to the grounds of rejection.

The comments (pages 6-7) regarding the rejection under 35 U.S.C. 112 first paragraph are not persuasive. The rejection remains for the reasons indicted in the prior Office Actions. Applicant's comments regarding examples 2-6 have been considered, however, but as discussed in the prior Office Actions, the comments are not persuasive. The citation of the M.P.E.P. 2163.03 is noted as to the asserted four situations, however, these are not the criteria for used in assessing an application for conformance to 35 U.S.C. 112 first paragraph. The criteria are indicated in the statute which indicated that the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The claims remain rejected under 35 U.S.C. 112 second paragraph for the reasons indicated in the prior Office Actions. Claim 1 is indefinite because the where "increasing the therapeutic effect of a cancer therapy" is recited, the "subjecting said tumor cell to said cancer therapy" does not indicate what is the effect of the therapy nor what that therapy does nor does the recitation of delivering the "wild-type p53 gene" indicate what the effect of that gene accomplishes with respect to the therapy nor is it indicated how effecting expression modifies "subjecting said tumor cell to said cancer therapy" wherein it is not clear from the present claim terminology whether or not lethal doses are included or excluded. In claim 1, it is not clear what or which is the "wild-type p53 gene" nor what expression of the gene provides with regard to therapy nor does the claim indicate how the gene is delivered. Claim 2 is indefinite because the claim does not indicate what DNA is or is not the "wild-type p53 gene". Note also that claim 9 remains indefinite as it is not clear how the types of cancer cells differ from each other. For example how do ovarian cancer cells differ from urogenital cancer cells since ovarian cells

are part of the genitalia and how do colorectal cancer cells differ from anal cancer cells since both are from the same tissue area of the body, i.e., the cells forming part of the anus.

The claims remain rejected under 35 U.S.C. 103(a) as set forth in the prior Office Actions. The comments at page 7 assert improvement in the effect of cancer therapy, however, the claims do not *per se* recite any improvement. Insofar as the comments refer to increased sensitivity, the instant claims do not indicate what it is that is the increased sensitivity to the therapy. Thus, the comments regarding sensitization are not persuasive. The additional comments at page 8 regarding the references cited in the stated grounds of rejection have been considered but they are not persuasive for the reasons set forth in the prior Office Actions. The response asserts that the Cheng *et al.* reference would lead one to believe the cells treated with DNA encoding p53 are more resistant to therapy is noted but not persuasive (nor does the response point to any part of the Cheng *et al.* reference that directly supports applicant's contention - i.e., applicant's assertion is not supported by the reference). Moreover, the effect of p53 is the same not different - the compound (i.e., the DNA is expected to have the same properties and the protein p53 is expected to have the same properties as any other wild-type p53. Thus, the property of "increased sensitivity" has not been demonstrated in the present application to be anything other than that which is part of the p53 protein nor is a function of p53 unexpected. The response also cites a reference by Vogelstein *et al.* (not provided with this or applicant's prior responses) for which applicant relies upon the indication of p53 mutations as increasing rather than decreasing the sensitivity of cells to antitumor agents. The comment is noted but is not persuasive of the instant claims since the Vogelstein *et al.* reference as asserted in the response would lead one to use mutant p53 to sensitize the cells but it is the mutant p53 product that is an effector of the neoplastic state of the cells. Thus, the reference is not definitive nor does the reference present factual data to support the applicant's arguments.

Applicant's response at page 9 is noted as citing the *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.* decision for unexpected/surprising results, however, as pointed out above, the asserted effect is that produced by the wild-type gene product that is encoded by the wild-type gene. The same gene is expected to produce the same effective product that has the same effect. Neither the present application nor any of applicant's responses demonstrate that the wild-type gene is any

different from the cited art. Thus, the comments in the response are not persuasive. Insofar as page 9 refers to cisplatin treatment as more effective in cells with wild-type p53 than in cells lacking same is contrary to applicant's own use of the Vogelstein *et al.* reference teaching of "p53 mutations may therefore constitute one of the few alterations that increase rather than decrease the sensitivity of cells to antitumor agents". Thus, applicant's own comments contradict the Vogelstein *et al.* reference and the Vogelstein *et al.* reference used in the manner asserted in applicant's response at page 9 contradicts the cited examples in the application. As to the asserted results not being reported or inferred in the references, the instant claims do not indicate cisplatin or radiation. Thus, applicant's arguments are inconsistent and not persuasive.

Inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Low whose telephone number is (703) 308-2923. Inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission to Group 1800 via the PTO Fax Center located in Crystal Mall 1 (CM1) and must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The telephone number assigned to Art Unit 1804 in the CM1 PTO Fax Center is (703) 308-0294.

CSFL
7 March 1997

Christopher S. F. Low

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PRIMARY EXAMINER
GROUP 1800